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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT PAPER NUMBER

2683

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/903,329

Applicant(s)

BATES ET AL.

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-35 and 37-45 is/are rejected.
- 7) ☒ Claim(s) 12, 36 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 10-25-04 have been fully and a new non-final rejection is provided below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4, 6, 13 and 16 and 27-35 and 37-45** rejected under 35 U.S.C. 102(e) as being anticipated by Chavez Jr. et al. US 6,539,232 (hereafter Chavez).

As per **claims 1, 27, 31-32, 33, 37 and 42**, Chavez teaches a method for connecting a user of a portable communication device (title and abstract) comprising:

Determining a location of a first portable communication device of a first user (C1, L39-49 teaches locating a user's position and connecting/disconnecting to a call group);

Determining a location of a second portable communication device of a second user (C1, L39-49);

Determining whether the location of the second device is within a same region/threshold/distance containing the first device (abstract teaches either connecting/disconnecting to a call group based on the location of the users as do figures 4-7. Also, figure 11, steps 1107 and 1108 show that a user within the same region as others receives a "list and data of other wireless terminals" as said user roams near those users of a specific call group); and

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Connecting/Notifying the first user of a presence of the second user if the location of the second device is within the same region/threshold/distance containing the first portable device (figure 12 steps 1201 to 1206 teaches the system determining if a user is in the call group and/or has left the call group region, whereby they are notified that the user has left. The examiner notes that figure 11, steps 1107-1108 teaches the "front-end" of this operation whereby a user joins a call group and is connected/notified of the presence of other users in that region/call group).

The examiner interprets that a user who roams into a call group will be able to join and receive "data" from the other users.

As per **claims 2, 28-30, 34, 38-39 and 43**, Chavez teaches claim 1/27/33 wherein the first and second users are members of a group/friends (eg. call group, C1, L39-49).

As per **claim 3**, Chavez teaches claim 1 wherein at least one of the first device and second device comprise a wireless device (figure 1 show wireless devices and wireless switching system).

As per **claim 4**, Chavez teaches claim 3 wherein the device comprises one of a mobile phone, a PDA and a two-way pager (C1, L41 teaches "wireless terminals" which reads on mobile phones, PDA's and pagers since they operate on RF frequencies too).

As per **claims 6, 31, 35, 41 and 44**, Chavez teaches wherein notification comprises automatically sending a signal to the first/second portable device (figure 11, steps 1103-1109 show automatic updating of tables as a user joins having roamed into the region).

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As per **claim 13**, Chavez teaches claim 1 wherein the determining the location of the second device and the notifying is repeated for all other members of a group containing the first user (figure 11 steps 1103-1109 teaches a user being added to a call group and figure 12, step 1203 shows data sent to others as well).

As per **claims 16, 40 and 45**, Chavez teaches claim 1/37/42 wherein the second device is within the same area as the first device if the location of the second device is less than a threshold distance from the location of the first device (C1, L39-49 teaches a user roaming into the call group region whereby they are added to the call group which inherently requires a threshold distance perimeter such that the user is either within the perimeter [and added to the call group] and/or outside the perimeter [and not added]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5 and 7** rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez.

As per **claim 5**, Chavez is **silent on** wherein the first and second devices comprise a laptop computer.

The examiner takes Official Notice that computing operations are found in mobile devices, such as PDA's and wireless phones, hence one skilled would substitute a laptop computer for the wireless terminals as described by Chavez.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that a laptop computer is used, to provide means for the system to work with mobile computing devices.

As per **claim 7**, Chavez teaches claim 1 wherein the determining the location of the first device comprises obtaining the location of the first device **but is silent on use of GPS** contained in the first portable device.

The examiner takes Official Notice that GPS systems are well known in the art and provide means for determining the location of a user. Also, mobile phones with GPS capability are well known too.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that GPS is used, to provide means for utilizing an alternate location system should the primary system fail and/or be ineffective (eg. as the user roams between building, the intra-office system taught by Chavez may not work optimally, hence GPS will be better used in an outdoor environment).

**Claims 8-9 and 11** rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez as applied to claim 1 above, and further in view of Holland US 6,321,091 (hereafter Holland).

As per **claim 8**, Chavez teaches claim 1 **but is silent on** wherein the determining the location of the second device comprises:

Receiving information from a network, where the information in the network contains the location of the second device transmitted from the second device; and

Identifying the location of the second user from the received information.

Holland teaches a portable locator system (title, abstract) whereby the portable device can determine its location and transmit location data to the network and/or subscriber computer externally attached to network (figure 1 shows device #12 and cellular provider network #28 and subscriber computer #48). The location data from the portable device will allow another to identify the location of the second user based the received information.

As per **claim 9**, Chavez teaches claim 8 where in the network comprises at least one of an Internet and a wireless network (figure 1 shows a wireless system connecting to the PSTN which can connect to the Internet. The examiner takes Official Notice that wireless phone have Internet capability).

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As per **claim 11**, Chavez teaches claim 8 wherein the determining whether the first and second devices are in the same region is performed by the network (C1, L39-49 teaches the system determining the location of the user and updating call group tables per figures 11-12).

**Claims 14-15** rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez as applied to claim 1 above, and further in view of Dunko et al. US 6,553,236 (hereafter Dunko).

As per **claim 14**, Chavez teaches claim 1 **but is silent on** further comprising:

Determining, if the location of the second device is outside the area containing the first device, whether the second device is about to approach the same area containing the first device; and

Notifying the first user of the impending presence of the second user in the same area if the second device is about to approach the same area containing the first device.

Dunko teaches on-demand location determination for affinity groups that want to know the location of other members (title and abstract) whereby situational alarms (eg. notifications) that users may program (figure 5) are based on the reported locations of the mobile terminals used by members of the affinity group - Initially, users must form an affinity group and subsequently program a situational alarm (the variations on this are limitless) - Some individuals may wish to know when two particular members of the affinity group are at the mall. Others may want to know when any two members of the affinity group are within a city block of one another. Others may want to know when any affinity group member is approaching the present location of the member (C11, L5-19).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that a user is notified if another user is approaching the same area, to provide apriori notification means to a member when another is NOT within the predetermined area but is approaching the area.

As per **claim 15**, Chavez in view of Dunko teaches claim 14 **but is silent on** wherein the determining the location of the second device comprises:

Determining a rate of travel and a direction of travel of the second device of the second user.

Dunko teaches location determination that can also provide information indicating travel direction and velocity (C8, L3-12).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that rate of travel and direction of travel are computed, to provide means for the system to determine location based on a plurality of information, including GPS, TDOA, AOA and rate/direction of travel.

**Claims 10 and 17-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Chavez as applied to claim 1, 17 and 24 above, and further in view of Grube et al. US 5,689,809 and Holland US 6,321,091 (hereafter Grube and Holland).

As per **claim 10**, Chavez teaches claim 8 **but is silent on** wherein the determining whether the first and second devices are in the same region is performed by the first device.

Grube teaches a wireless device that can receive location information about a different device and, using its own location information, determine a geographic relationship between the two devices (abstract and figure 2 and C2, L13-61). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the combination of Chavez and Holland, such that the portable device can receive location information and perform distance calculations, to provide means for the phone to receive and calculate position information without support from the network.

As per **claim 17**, Chavez teaches a portable communication device and a network interface for receiving information from the network (figure 1, shows RF/cellular system) and a processor that executes a group alert program configured to determine whether the location of another portable device is within a same region as the retrieved location and if so, cause a notification message to be sent to the user of a presence of the another user if the location of the another device is within the same region as the portable device (C1, L39-49 teaches a "system" performing these functions to connect



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between two units when within a predetermined distance from each other – hence both first and second units are notified since the connection is set-up) **but is silent on**

The portable notifying a user of the presence of another user comprising:

A position detector for determining a location of a portable device;

A memory for storing a user alert program

wherein the network information includes location information indicative of a location of another portable device of another user.

Holland teaches a portable location device (figure 1, #12) which has a CPU, memory and cellular transceiver/modem to allow the device to determine its position (abstract, figures 1-3 and C2, L20-27). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that portable device has a CPU, memory and RF transceiver, to provide means for the device to carry out position determination as a stand-alone unit without need of communicating with the network.

Grube teaches a wireless device that can receive location information about a first device and, using its own location information, determine a geographic relationship between the two devices (abstract and figure 2 and C2, L13-61). Hence, this provides motivation to move the location/notification functionality from the network in Chavez to the mobile device per Grube. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the combination of Chavez and Holland, such that the portable device can receive location information and perform distance calculations, to provide means for the phone to receive and calculate position information without support from the network.

As per **claim 18**, Chavez in view of Holland and Grube teaches claim 17 **but is silent on** use of GPS.

The examiner takes Official Notice that GPS systems are well known in the art and provide means for determining the location of a user. Also, mobile phones with GPS capability are well known too.

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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that GPS is used, to provide means for utilizing an alternate location system should the primary system fail and/or be ineffective (eg. as the user roams between building, the intra-office system taught by Chavez may not work optimally, hence GPS will be better used in an outdoor environment).

As per **claim 19**, Chavez in view of Holland and Grube teaches claim 17 **but is silent on** comprising:

An input device for providing commands to the processor; and

An output device for displaying the retrieved location.

Holland teaches a control interface (figure 1, #21) that accepts input commands from a user (C6, L28-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that the device has input for user commands, to provide means for the user to control the unit as they require.

Grube teaches determination of geographic relationships between portable units (title) whereby the relationship/distance is displayed visually and audibly (abstract, also see displays in figure 1, #115 and #116). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that the device has an output to display location data, to provide means for the user to view position data visually.

As per **claim 20**, Chavez in view of Holland and Grube teaches claim 17 wherein the first user and the second users are members of a (call) group (C1, L39-49)

As per **claim 21**, Chavez in view of Holland and Grube teaches claim 21 wherein the network comprises at least one of an Internet and wireless network (figure 1 shows wireless terminals connected to the wireless network/PSTN. The examiner takes Official Notice that wireless terminals can connect to the Internet).

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As per **claim 22**, Chavez in view of Holland and Grube teaches claim 17 **but is silent on** wherein the retrieved location is transmitted to the network for processing by the another portable device.

Grube teaches a wireless device that can receive location information about a first device and, using its own location information, determine a geographic relationship between the two devices (abstract and figure 2 and C2, L13-61). Hence, this provides motivation to move the location/notification functionality from the network in Chavez to the mobile device per Grube. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the combination of Chavez and Holland, such that the portable device can receive location information and perform distance calculations, to provide means for the phone to receive and calculate position information without support from the network.

As per **claim 23**, Chavez in view of Holland and Grube teaches claim 17 wherein the another portable device is in the same region as the retrieved location if the another portable device is less than a threshold distance from the retrieved location (C1, L39-49).

As per **claim 24**, Chavez teaches a system for connecting a user of a portable communication device (title and abstract) comprising:

Determining a location of a first portable communication device of a first user (C1, L39-49 teaches locating a user's position and connecting/disconnecting to a call group);

Determining a location of a second portable communication device of a second user (C1, L39-49);

A network configured for:

Determining whether the location of the second device is within a same region/threshold/distance containing the first device (abstract teaches either connecting/disconnecting to a call group based on the location of the users as do figures 4-7. Also, figure 11, steps 1107 and 1108 show that a user within the same

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region as others receives a "list and data of other wireless terminals" as said user roams near those users of a specific call group); and

Connecting/Notifying the first user of a presence of the second user if the location of the second device is within the same region/threshold/distance containing the first portable device (figure 12 steps 1201 to 1206 teaches the system determining if a user is in the call group and/or has left the call group region, whereby they are notified that the user has left. The examiner notes that figure 11, steps 1107-1108 teaches the "front-end" of this operation whereby a user joins a call group and is connected/notified of the presence of other users in that region/call group).

The examiner interprets that a user who roams into a call group will be able to join and receive "data" from the other users.

**But is silent on** first and second devices determining their location and the network receiving the transmitted location of second portable device.

Holland teaches a portable location device (figure 1, #12) which has a CPU, memory and cellular transceiver/modem to allow the device to determine its position (abstract, figures 1-3 and C2, L20-27) which can be sent to the network (figure 1 shows location data transmitted to cell provider, #26, server computer #38 and subscriber computer #46). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Chavez, such that portable devices can determine their position and send it to the network, to provide means for the device to carry out position determination as a stand-alone unit without need of communicating with the network.

Grube teaches a wireless device that can receive location information about a first device and, using its own location information, determine a geographic relationship between the two devices (abstract and figure 2 and C2, L13-61). Hence, this provides motivation to move the location/notification functionality from the network in Chavez to the mobile device per Grube. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the combination of Chavez and Holland, such that the portable device can receive location information and perform distance

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calculations, to provide means for the phone to receive and calculate position information.

As per **claim 25**, Chavez in view of Holland and Grube teaches claim 24 wherein at least one of the first and second devices comprise a wireless phone (figure 1).

As per **claim 26**, Chavez in view of Holland and Grube teaches claim 24 wherein the network is configured for wireless communication (figure 1 shows mobile phones and base stations).

***Allowable Subject Matter***

**Claims 12, 36 and 46** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach:

Determining a common meeting point for the first and second users:

Notifying the first user of the common meeting point on the first portable device;

Notifying the second user of the common meeting point on the second device

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta  
1-25-05



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